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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/925,782	08/09/2001	Rabindranath Dutta	AUS920010241 US1	4227

7590 09/22/2004
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EXAMINER

EHICHIOYA, FRED I

ART UNIT PAPER NUMBER

2172

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/925,782

Applicant(s)

DUTTA ET AL.

Examiner

Fred I. Ehichioya

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 27 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1 - 27 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, with respect to claims 1 – 27, filed May 17, 2004 have been fully considered but they are not persuasive for the following reasons.

2. Applicants argue:

(a) the references do not teach or suggest “determining whether . . . the patent access instruction” (Page 5, Para 3).

(b) Schoenberg in view of Brinkman fails to teach or suggest “receiving patient access instructions at the aggregate medical server” or “sending a portion . . . corresponds with the access request” (Page 7, Para 3).

(c) Schoenberg in view of Brinkman fails to teach or suggest that the access instructions include alert instructions (Page 8, Para 1).

(d) Schoenberg in view of Brinkman fails to teach or suggest “generating alerts over the network . . . subsequent to receiving adverse medical data” (Page 8, Para 2).

3. Examiner respectfully disagrees with all of the allegations as argued. Examiner, in his previous office action, pointed out exact locations in the cited prior art.

In response to Applicants' argument (a): Brinkman discloses determining whether . . . the patent access instruction (see column 14, lines 14 – 22).

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In response to Applicants' argument (b): Schoenberg teaches receiving patient access instructions at the aggregate medical server (see column 2, lines 11 – 53 and column 6, lines 4 – 9).

Brinkman discloses sending a portion . . . corresponds with the access request (see column 6, lines 4 – 9 and column 10, lines 62 – 67).

The motivation for combining Brinkman with Schoenberg is that this system provides confidential health and disease management advice that is directly tailored to member specific needs.

In response to Applicants' argument (c): Brinkman teaches that the access instructions include alert instructions (see column 4, lines 40 – 42)

In response to Applicants' argument (d): Brinkman teach generating alerts over the network . . . subsequent to receiving adverse medical data (see column 15, lines 50 – 67).

4. In view of the above, the examiner contends that all limitations as recited in the claims have been addressed in this Action. For the above reasons, Examiner believed that rejection of the last Office action was proper.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1 – 5, 8 – 19, and 22 - 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,322,502 issued to Ido Schoenberg et al (hereinafter "Schoenberg") in view of U.S. Patent 6,697,783 issued to Thomas Brinkman et al (hereinafter "Brinkman").

Regarding claim 1, Schoenberg teaches a method of receiving patient medical information at an aggregate medical server (see column 2, lines 49 – 53);

receiving patient access instructions at the aggregate medical server (see column 2, lines 11 – 53 and column 6, lines 4 - 9);

receiving an access request from a requestor at the aggregate medical server (see column 6, lines 4 – 9 and column 10, lines 62 - 67);

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Schoenberg does not explicitly teach determining whether the access request corresponds with the patient access instructions; and sending a portion of the patient medical information to the requestor based on the patient access instructions and the access request if the patient access instructions corresponds with the access request (see column 10, lines 14 – 20).

Brinkman teaches determining whether the access request corresponds with the patient access instructions (see column 14, lines 14 - 22); and

sending a portion of the patient medical information to the requestor based on the patient access instructions and the access request if the patient access instructions corresponds with the access request (see column 10, lines 30 - 47).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Brinkman with the teaching of Schoenberg wherein user's is restricted to certain databases or portion thereof based on the user's level of authorization. The motivation is that the system is able to prevent unauthorized access to patient medical record.

Regarding claim 2, Brinkman teaches patient access instructions include alert instructions (see column 4, lines 40 - 42).

Regarding claim 3, Brinkman teaches generating alerts saver the network to any of a healthcare provider, a patient, a treatment facility or a government agency subsequent to receiving adverse medical data (see column 15, lines 50 - 67).

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Regarding claim 4, Schoenberg teaches providing a hyperlink to the aggregate server wherein the hyperlink comprises the access request (see column 6, lines 5 - 8).

Regarding claim 5, Brinkman teaches the hyperlink is provided on a web site for access by the requestor (see column 8, lines 16 - 19).

Regarding claim 8, Brinkman teaches verifying a portion of the patient medical information with an outside server (see column 14, lines 20 - 30).

Regarding claim 9, Brinkman teaches verifying the portion of the patient medical information comprises determining a patient eligibility (see column 9, lines 37 - 40).

Regarding claim 10, Brinkman teaches updating the patient medical information (see column 4, lines 19 - 22).

Regarding claim 11, Brinkman teaches the patient medical information is selected from a group consisting of a name, a social security number, a plan number, personal information, medical history information, medical claims information, prescription information, insurance company information, billing information, healthcare provider information, record ID, date of service and code (see column 9, lines 21 - 33).

Regarding claim 12, Brinkman teaches the access information comprises level authorization information (see column 11, lines 19 - 24).

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Regarding claim 13, Schoenberg teaches wherein level authorization comprises restriction to a patient medical information category (see column 6, lines 20 - 36).

Regarding claim 14, Brinkman teaches the patient medical information category is selected from a group consisting of laboratory services, healthcare providers, pharmacy services and diagnostic services (see column 13, lines 28 - 59).

Claims 15 - 19 and 22 - 26 are essentially the same as claims 1 - 5 and 8 - 12 respectively except that they set forth the claimed invention as a computer usable medium rather than a method and therefore rejected for the same reasons as applied hereinabove.

Claim 27 is essentially the same as claim 1 except that it sets forth the claimed invention as a system rather than a method and therefore rejected for the same reasons as applied hereinabove.

7. Claims 6, 7, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schoenberg in view of Brinkman and further in view of U.S. Patent 6,260,021 issued to Stephen Wong et al (hereinafter "Wong").

Regarding claim 6, Schoenberg or Brinkman does not explicitly teach wherein determining whether the access request corresponds with the patient access instructions further comprises implementing at least one security feature.

Wong teach wherein determining whether the access request corresponds with the patient access instructions further comprises implementing at least one security feature (see column 10, lines 28 - 47).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Wong with the teaching of Schoenberg and Brinkman wherein security object server provides security and access control information necessary to protect medical information from unauthorized access. The motivation is that the security object server is able to implement security and control access to medical information.

Regarding claim 7, Wong teaches wherein the security feature is selected from a group consisting of a user password, a public, key cryptograph, a digital signature, and an XML based security standard (see column 13, lines 7 - 44).

Claims 6 and 7 are essentially the same as claims 20 and 21 respectively except that they set forth the claimed invention as a computer usable medium rather than a method and therefore rejected for the same reasons as applied hereinabove.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred I. Ehichioya whose telephone number is 703-305-8039. The examiner can normally be reached on M - F 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on 703-305-9790. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Fred I. Ehichioya
Examiner
Art Unit 2172
September 16, 2004

Alford W. Kindred
af W. Kindred